

USSN 10/068,686
Amendment in Response to March 14, 2005 Office Action

REMARKS

In the March 14, 2005 office action, claims 2, 5-6, 8, 12 and 14-31 were all rejected under 35 USC 103(a) as being unpatentable for being obvious over USP 3,896,589 to Mitchell in view of USP 5,253,051 to McManigal.¹

Claims 2, 5-6, 8, 12 and 14-31, are being resubmitted for the Examiner's consideration in view of the remarks presented herein.

REJECTION UNDER 35 U.S.C. §103(a):

Claims 2, 5-6, 8, 12 and 14-31 were all rejected under 35 U.S.C. § 103(a) as being unpatentable over USP 3,896,589 ("Mitchell") in view of USP 5,253,051 ("McManigal"). Independent claims 14, 17, 19 and 21 all recite "a window frame disposed in a wall of a structure" (emphasis added) and call for a window "housed" or "movable" in the window frame. In addition, these claims all call for a display.

For reasons stated below, the rejection is traversed.

A. One skilled in the art would not modify Mitchell as taught by McManigal, since McManigal teaches away from placing a display in Mitchell's window

Mitchell, which issued in 1975, simply discloses a window frame having movable window sashes. These structures are very well known in the prior art.

McManigal, which issued in 1993, discloses an electronic display which is (1) mounted on an interior wall of a room, (2) framed to have the appearance of a window frame, (3) configured to receive signals comprising scenery; and (4) provided with a detector to locate a viewer in the room and change the scenery perspective accordingly.

McManigal teaches nothing about mounting anything *in* an opening of a structure, let alone a window; McManigal only teaches hanging an artificial window *on* an interior wall or in the middle of a room.

¹ It is noted that in the August 4, 2004 office action, all claims were rejected over McManigal in view of Mitchell. Thus, the Examiner has simply reversed the primary and secondary references.

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More significantly, however, McManigal *teaches away* from placing such a display in a window frame disposed in wall of a structure:

It is a major object to provide an artificial window construction or constructions . . . Basically, the apparatus of the invention comprises: a) a frame having window room configuration to be supported within a room, b) video means including a display encompassed by the frame . . .²

[the] frame 12 has a room window configuration . . . It is configured to be supported within a room chamber, the interior of which is indicated at 80.
(emphasis added)

An inspection of McManigal's figures further bears this out. McManigal's Figs. 2 & 2a show a building wall 81 separating a building interior 80 from a building exterior 82. McManigal's display 10 clearly is not mounted in a wall of the structure, as recited in each of the pending independent claims, but only in the interior of the structure. Furthermore, the entire purpose of McManigal is to provide an "artificial window" when a real window is not feasible or desired:

From the foregoing it will be seen that the invention allowed many of the advantages of a window looking out onto a very interesting outdoor scene where there is no window.³

In view of the foregoing, it is submitted that one skilled in the art would not modify Mitchell to have the display of McManigal, since McManigal specifically states that its teachings are inapplicable when one has the window of the sort disclosed in Mitchell.

If the rejection is maintained, the Examiner is kindly asked to explain why one skilled in the art, upon reading McManigal's unambiguous statements that the invention is not relevant to settings in which windows are present, would nonetheless employ McManigal's teachings to the window of Mitchell.

II. The alleged motivation to modify Mitchell as taught by McManigal does not exist

On page 3 of the March 14, 2005 office action, the Examiner concedes that Mitchell does not disclose a display. For this feature, the Examiner turns to McManigal, which discloses an

² USP 5,253,051 at col. 1, lines 31-36 (emphasis added)

³ UPS 5,253,051 at col. 5, lines 66 – col. 6, line 2 (emphasis added)

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electronic display configured to simulate the effect of a real window. In explaining the motivation to combine the two references, the Examiner argues:

it would have been obvious to one of ordinary skill in the art at the time of (sic) the invention was made to provide a display module in the first or second window of Mitchell, in view of the teaching in the McManigal reference, because this would provide the user to view simultaneously the outside scene and the selected scene presented at the video display, as recognized by one of ordinary skill in the art as taught by McManigal. (emphasis added)

This motivation makes little sense. The whole point of McManigal is to provide an artificial scene where there is *no* window present. In Mitchell, one already *has* a window through which the outside scene may be viewed. One already having the window (and view) of Mitchell would therefore not need to modify Mitchell's window so as to "view simultaneously the outside scene", as suggested by the Examiner. In other words, the motivation suggested by the Examiner would lead to a window assembly permitting one to view the same scene both directly *through the window* and also on a display *mounted on the window*. Because of this apparent redundancy, it is submitted that one skilled in the art would not modify the window for the reason set forth by the Examiner.

If the rejection is maintained, the Examiner is kindly asked to explain why one skilled in the art would modify a window so as to view the same outside scene both (a) directly through window and (b) also on a display showing that same thing.

III. The two references are non-analogous art and only by hindsight could the Examiner have suggested that Mitchell be modified by McManigal

It is particularly noted that in the 9 years from the 1993 issuance of McManigal⁴ to the 2002 filing of the present application, no other entity has come up with a "real window"/electronic display combination, as presently claimed.

Mitchell, which is directed to a window frame and movable sash windows, belongs to U.S. Class 49 ("Movable or Removable Closures"). Mitchell makes no mention of incorporating a display for any reason.

⁴ Mitchell issued in 1975 and so McManigal is the newer of the two references by some 18 years

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McManigal, which is directed to an electronic display, belongs to current U.S. Class/Subclass 348/121 ("Television"/"Simulator"). McManigal makes no mention of *anything* mounted in an opening of a structure, let alone a window. Moreover, as discussed above, McManigal specifically *teaches away* from a window frame disposed in wall of a structure.

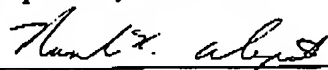
In view of the foregoing, it is submitted that (a) these two references are non-analogous art and so should never have been combined; and (b) only through impermissible hindsight upon viewing the pending claims could the Examiner have combined the two references. Nothing in either reference suggests the combination arrived at by the Examiner.

With respect to all claims not specifically mentioned, it is submitted that these are patentable not only by virtue of their dependency on their respective based claims and any intervening claims, but also for the totality of features recited therein.

Reconsideration of the application is requested. Claims 2, 5-6, 9, 12 and 14-31 are believed to be in allowable form and define over the prior art. An early notice of allowance is requested so that the application may proceed to issue. Should the Examiner have any questions or comments regarding the foregoing Amendment and response, he is invited and urged to telephone the undersigned attorney.

The Commissioner is hereby authorized to charge any additional fees that may be required for the timely consideration of this Amendment under 37 C.F.R. §§ 1.16 and 1.17, or credit any overpayment to Deposit Account No. 09-0528.

Respectfully Submitted,

Date: June 13, 2005

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